REMARKS

Claims 1-88 are in the application.

Claims 1-82 are rejected under 35 U.S.C. § 102(b) as being anticipated by Exhibit "O", or obvious over Exhibit "O" in view of Exhibit "L" and/or Teper (US 5,815,665). Claims 83-88 are not specifically rejected.

The Examiner is incorrect in his analysis of Exhibit "O". This exhibit clearly states that the micropayment system was not implemented at the time of writing. "Transaction-handling capabilities, and an initial base of Publishing Members, will be launched in early 1996... At that point, publishers will be able to sell each others' information for as little as a dime per click, exchanging royalties and commissions seamlessly," added Densmore." Therefore, the reference cannot be interpreted to "disclose" that which it admits does not exist. Likewise, applicants have previously presented evidence that the technology remained experimental, at best, and was not yet reduced to practice, nor ready for patenting, as of the date of Exhibit "O". Indeed, it is clear that Exhibit "O" does not disclose any details, and merely proposes an ideal or project definition to be met by the ultimate product and service. The Examiner's statement on page 17 of the office action that Exhibit "O" is enabling is unsupported and lacking any factual analysis, and in the presence of a factual challenge by applicants, must be further elucidated.

The reference is therefore, at best, an invitation to experiment, and not a recipe for reducing the invention to practice, in a manner which would enable one of ordinary skill in the art to practice

the invention. It is well established law that the mere statement of a problem to be solved does not anticipate the solution to that problem, and the validity of the patent therefore depends on whether a person of ordinary skill in the art, at the time of the invention, would have sufficiently possessed the invention to render it obvious. Applicants respectfully submit that, in the present case, they did not.

In fact, the invention was intended for use over a public network, such as the Internet, and the mere theoretical aggregation of aspects and intended outcomes is insufficient to define a workable embodiment, since such issues as lost packets, protocol overhead, browser behavior, firewalls, network congestion, compatibility and relationships among various parties, contention of multiple processes for limited resources, all had to be considered in order to determine whether the architecture was suitable for its intended purpose. As of the date of the reference, this is clearly not established, and applicant should not be penalized for delaying filing of the patent application until after the invention was proven to be operable for its intended purpose.

In reviewing Exhibit "O", it is apparent that various elements of claim 1 appear to be drafted in accordance with 35 U.S.C. § 112, sixth paragraph (means plus function), e.g., "payment means", and applicant is entitled to a claim scope commensurate with its disclosure. Therefore, since Exhibit "O" discloses no corresponding structures, it does not anticipate the claim as properly interpreted. Likewise, it does not render the claim obvious, since one of ordinary skill in the art would not have been enabled by the prior art, including Exhibit "O", to make and use the invention at that time. See, In re Kollar, 286 F.3d 1326, 1329 (Fed. Cir. 2002); Minn. Mining & Mfg. Co. v. Chemque, Inc., 303 F.3d 1294, 1301 (Fed. Cir. 2002).

Prior art under § 102(b) must sufficiently describe a claimed invention to have placed the public

in possession of that invention. In re Donohue, 766 F.2d 531, 533 (Fed. Cir. 1985); In re

Samour, 571 F.2d 559, 562 (CCPA 1978). The proper test of a publication as a § 102(b) bar is

"whether one skilled in the art to which the invention pertains could take the description of the

invention in the printed publication and combine it with his own knowledge of the particular art

and from this combination be put in possession of the invention on which a patent is sought." In

re LeGrice, 301 F.2d 929, 939 (CCPA 1962). In particular, one must be able to make the

claimed invention without undue experimentation. In Re Elsner, 381 F.3d 1125, 1126, 72

USPQ2d 1038, 1040 (Fed. Cir. 2004). See also, In re Kumar, 418 F.3d 1361, 1368 (Fed. Cir.

2005)("[I]n order to render an invention unpatentable for obviousness, the prior art must enable a

person of ordinary skill to make and use the invention.") (citing Beckman Instruments, Inc. v.

LKB Produkter AB, 892 F.2d 1547, 1551 (Fed. Cir. 1989)).

Exhibit "O" clearly does not enable the practice of the present invention, and merely describes a

high level architecture without sufficient specificity. One seeking to implement the invention

based on the description provided would have required the exercise of inventive skill.

Finally, Exhibit "O" fails to teach or suggest substantial elements of the claims, and such

deficiencies are not remediated by any of the other references of record. For example, elements

"c" of claim 1 requires "a settling means, separate from a respective home provider, for settling

accounts among service providers by charging the home provider for access by its clients to the

resources of the outside providers, the settling means accessing a respective home provider

registration database, and communicating with an accounting database maintained separately from a respective registration database". The examiner proposes that the following excerpt from Exhibit "O" teaches this element: "Clickshare tracks content served to users regardless of the location of their "home" Publishing Member. Aggregate micro-charges, settled monthly or more frequently, allocating commissions, royalties and transaction fees, thus form the basis of a system resembling an ATM network." In fact, this excerpt (and the remainder of Exhibit "O", fail to teach or suggest a settling means for accessing a respective home provider registration database, or a separation of the accounting database and the registration database – a key distinguishing feature of the invention.

The Examiner Addresses this issue on page 17 of the Office Action; however, applicants respectfully request reconsideration thereof. While Exhibit "O" proposes that the aggregate microcharges are settled monthly or more frequently, it fails to indicate the architectural features as claimed by applicant. It is respectfully submitted that these features are neither taught nor suggested by the reference.

Element "d" of claim 1 requires "a payment means adapted to assure that the outside providers are then paid for that access." The excerpt of Exhibit "O" cited by the examiner allegedly corresponding to this element provides: "A portion of all fees accumulated by a user for all visited Clickshare-enabled sites is retained by the user's home Publishing Member. This is termed a "referral commission." And Newshare retains a portion for its role in tracking and clearing transactions. At least 50 percent of each transaction goes to the content owner as a royalty." It is not seen how this disclosure supports the required "assurance" as contrasted with

the stated intent to compensate the content owner. While a skilled artisan might set out to construct such a payment system to assure payment, it is respectfully submitted that the features required, within the context of the present invention, to "assure" payment, would require the exercise of inventive skill, for example, to consider such issues as redistribution of content, search engine spiders, browser page refresh, etc. Further, the excerpt teaches a suggested implementation of business and financial relationships among parties which would be supported by the system, not the workings of the system itself.

Element "e" of claim 1 requires "a verification means … to … determine that client's access privileges and criteria." The allegedly corresponding excerpt from Exhibit "O" states: "The second piece of essential software, the Clickshare token-validation service (TVS) server, is run by Newshare Corp. or licensees. It creates and validates authentication tokens, brokers non-personal user preferences among publishers, and maintains "page visit" records from multiple independent sites sortable by anonymous user number, page visited and site ID." It is not seen how Exhibit "O" discloses client access privileges or criteria, nor how tokens are created or validated, nor where page visit records originated, transferred or stored.

In the same manner that the Examiner has focused on claim 1 as a "representative claim" for the examination of the application, applicants have also focused on this claim; however, applicants reserve the right to argue independent patentability of the remaining claims. It is noted that claim 18 appears to be a method corresponding closely to claim 1.

Claims 35-62 are rejected as being obvious over Exhibit "O" in view of Teper. The Examiner notes that the Declaration of Densmore was "previously found ineffective per the office action submitted on September 2, 2004". It is noted, however, that additional declarations are of record, including a Declaration of David M. Oliver, William P. Densmore, Jr., and Michael J. Callahan", dated August 12 2004 (specifically antedating Teper), was submitted with the response to the Office Action dated December 2, 2004, and the "Third Declaration of William P. Densmore Jr." dated October 3, 2005 (which does not directly address Teper, but does authenticate certain press releases which themselves demonstrate that the present invention antedated Teper), and therefore that it appears that less than all of the evidence available was considered when the Examiner formulated his conclusion that applicants' evidence was insufficient to overcome the reference.

Claim 63 is believed to distinguish Exhibit "O", in that Exhibit "O" fails to teach or suggest at least "an authentication protocol for allowing the SP site to authenticate registered users in response to user-specific authentication requests from the SP sites, the authentication requests responsive to requests from the user computers to access the online services of the SP sites, the authentication protocol implemented by software components of the user computers, the SP sites, and the online broker site."

Likewise, claim 69 is believed distinguished by at least the steps of:

> sending an access request from a computer of the user ("user computer") over the distributed network to the SP site;
> sending an authentication request from the SP site to the registration site in response to the access request;
> prompting the user for a user identifier at the user computer and sending the user identifier to the registration site;

authenticating the user at the registration site in response to the authentication request, the step of authenticating comprising using the user identifier sent from the user computer to access the account information stored within the registration database;

sending a verification message from the registration site to the SP site in response to the authentication request, the verification message indicating whether the step of authenticating was successful;

retrieving access rights data of the user from the registration database if the step of authenticating is successful, the access rights data specifying a plurality of access rights of the user with respect to the online service and/or the SP site;

sending the plurality of access rights data from the registration site to the SP site to anonymously inform the SP site of the access rights of the user;

providing the fee-based online service from the SP site to the user computer over the distributed network only if the verification message indicates that the step of authenticating was successful;

generation a billing event at the SP site and sending the billing event to the online broker site, the billing event anonymously identifying the user to the online brokering service, the billing event including a charge for the providing of the online service to the user computer; and

updating an account of the user at the online broker site to reflect the charge included within the billing event.

Claim 71 is believed to distinguish Exhibit "O" by providing at least:

a software package running at the online broker site, the brokerage software package performing at least the following functions:

(a) receiving identifying information about the user generated at the registration site to correlate an anonymous ID of a registered user with an identification of an account of a registered user;

(b) receiving user-specific billing events from the SP sites and passing the billing events to the billing system to update the accounts of registered users, each billing event specifying at least (1) an anonymous ID of a registered user, and (2) a charge to be applied to the account of the registered user; and

a software package running at the registration site, the registration software package performing at least the following functions:

(a) authenticating registered users in response to authentication requests received from the SP sites, the authentication requests generated in response to attempts by registered users to access online services of the SP sites, said authenticating comprising accessing the database to verify user account information;

(b) retrieving user-specific access rights data from the database in response to requests from the SP sites and transmitting the access rights data to the SP sites, the access rights data specifying a plurality of content categories or services to which a registered user has access and enabling the SP sites to provide customized access rights to the registered users; and

(c) generating an anonymous ID of a registered user for use by the SP sites and communicating the identifying information for correlating the anonymous ID with an identification of an account of a registered user to the online brokerage site.

Claim 75 is distinguished from Exhibit "O" by at least:

    a plurality of fee-based online services running on a plurality of independent service provider (SP) sites on the public network, the SP sites directly accessible to the users over the public network, each SP site being registered with the online brokering service and the registration service, and being configured to use the registration service to authenticate the users when the users connect to the SP sites over the public network, the fee-based services configured to generate account-specific billing events in response to uses of the online services by the users and to forward the billing events to the online brokering service so that the users are billed for the online services from a centralized billing location; and
    a log-on protocol which allows the users to access the plurality of online services using their respective accounts, the log-on protocol configured to (1) prompt a user for an account identifier, (2) cache the account identifier during the course of a user log-on session, and (3) use the cached account identifier to access multiple different SP sites, the log-on protocol thereby allowing the user to ¬seamlessly access the plurality of fee-based online services following a single log-on event;
    wherein the registration service stores user-specific access rights data, and provides the access rights data specifying access rights for a plurality of online services for a specific user to the SP sites in response to requests from the SP sites, and wherein the fee-based online services are configured to use the access rights data to automatically provide user-customized services to the users.

Claim 79 is distinguished from Exhibit "O" by at least:

    the at least one registration data structure including registration data of a plurality of a plurality of registered customers, the at least one data structure further comprising access rights relating to a plurality of online services;
    whereby the registration server facilitates seamless connection between a selected registered customer and an online site to create a virtual online service, including anonymously providing the selected customer's access rights to the plurality of online services provided by the selected online site, and
    whereby the broker server receives anonymous accounting information from the online site for charges of a customer and receives identifying information from the registration server to permit updating of account information for a respective registered customer.

Claim 81 is distinguished from Exhibit "O" by at least:

    (b)   a provider interface, through which a plurality of providers issue requests to post a transaction to a particular user account, without requiring knowledge of a respective user identity;
    (c)   a settlement server, receiving said requests, accessing at least one of said user registration databases, and communicating said request and an user identity to one of a plurality of user account databases;

Claim 82 is distinguished from Exhibit "O" by at least:

(b)   issuing a request to post a transaction to a particular user account, without requiring knowledge of a respective user identity by a posting party;
(c)   at a settlement server:
        (i)   receiving the request from the posting party,
        (ii)   accessing at least one of the user registration databases, and
        (iii)   communicating the request and an user identity to corresponding one of a plurality of user account databases; and

Applicants therefore respectfully submit that Exhibit "O" is not enabling (even for the system alluded to within its scope); that it does not disclose the entirety of the presently claimed invention, and further that the use of this document is but an invitation to experiment, and not a disclosure of the result of a substantial development effort, which resulted in the present invention.

It is therefore respectfully submitted that the invention, as claimed, is patentable.

Respectfully submitted,

/Steven M. Hoffberg/

Steven M. Hoffberg
Reg. 33,511

Milde & Hoffberg LLP
Suite 460, 10 Bank Street
White Plains, NY 10606
(914) 949-3100